

Appln No.: 10/644,640
Amendment Dated: July 8, 2005
Reply to Office Action of May 19, 2005

REMARKS/ARGUMENTS

This is in response to the Office Action mailed May 19, 2005 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Claim 8 has been amended to correct the erroneous dependency in view of the Examiner's rejection. In addition, claims 4, 6 and 10 have been amended to correct clerical errors.

The present application relates to a thermoplastic polyester resin composition. As defined in claim 1, the composition comprises an alkylene aryl polyester, a rubbery core shell impact modifier having defined characteristics, a difunctional epoxy compound, and a combination of three different and specific types of stabilizers. The stabilizers are identified in the claims as color enhancing stabilizers and have this affect in compositions where color change is visible, but are to be included regardless of the overall color of the material because of other benefits arising from the combination. The Examiner has rejected the claims as obvious over various combinations of references. While these rejections are addressed individually below, fundamental features of the claimed invention are applicable to all of the claims and are therefore addressed first.

In assessing obviousness, it is essential to not consider merely the words of the claim, but the actual claimed invention including all of its associated properties. Where results are set forth in the specification showing such properties, the Examiner must take these results into account in determining whether a rejection is appropriate. *In re Margolis*, 228 U.S.P.Q. 940, 942 (Fed. Cir. 1986).

In the present case, the combination of ingredients as defined in the claim is shown in the examples of the application to have unique properties with respect to color stability and impact strength retention on aging. For example, in Table 2 on Page 22, an example in accordance with the invention is compared with three comparative examples. Comparative Example A has two (not the claimed three) color stabilizers and a different impact modifier from that which is claimed. Comparative Example B has three color stabilizers and a different impact modifier. Comparative Example C has two color stabilizers and an impact modifier of the type claimed. The actual Example 1 has the same three stabilizers as Example B, and the impact modifier of Example C. As can be seen from the results, the level of color stability and other physical properties are dependent on the combination of ingredients, with the composition of the invention in Example 1 having significantly superior performance to the comparative examples. In this regard, it is important to observe that the stabilizers do not just serve for color enhancement, but also contribute to properties such as elongation.

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The same type of results are shown for an additional example according to the invention, and six comparative examples which all contain the same impact modifier but contain the color stabilizers in all possible combinations of one or two stabilizers. Only in the composition of the invention did the material perform well in all of the tests.

Claims 1,3, 4 and 9-20 are rejected under 35 USC § 103 as obvious over Gallucci et al. (US 6,300,399) in view of Gallucci et al. (US 5,596,409) and Fromuth et al. (US 4,264,487). The Examiner asserts that Gallucci '399 teaches all of the limitations of the claims except for the specific type of core shell polymers and the difunctional epoxy compound. Fromuth and Gallucci '409 are cited, respectively, as teaching these limitations, and the Examiner argues that it would have been obvious to use these materials in the composition of Gallucci '399. Applicants respectfully disagree.

As a first matter, it is pointed out that Gallucci '399 does not expressly teach combinations of color stabilizers. The examples all employ a single color stabilizer, although the patent discloses four materials, and states that these can be used individually or preferably in combination. Four materials, used individually or in combination, provide a total of 15 possibilities. Of these, only five (the four combinations of three and the one combination of all four) are within the scope of the present claims. The examples discussed above establish that these combinations are not equivalent to the others, and nothing in Gallucci '399 points to any preference for combinations of three or more, as opposed to combinations of two stabilizers.

Furthermore, Gallucci '399 discloses a variety of impact modifiers. These include a generic description of the core shell rubber of the type claimed, but also include olefin-containing copolymers such as olefin acrylates, polyolefins such as polyethylene, polyolefin coolymers with glycidyl acrylates, and styrene-containing polymers such as MBS. The most preferred impact modifier referenced in Gallucci '399 is a poly(ether ester) which is not the impact modifier specified in the compositions of the invention.

As observed in MPEP § 2144.08, "the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994)." Nothing in Gallucci '399 directs the selection of the specific combination of three or more color stabilizers and an acrylate core shell impact modifier. Furthermore, nothing in Gallucci '399 suggests the properties of the compositions that result from this selection.

The secondary references do not modify this conclusion. The Examiner has cited them as showing additional materials used in polyester compositions, but they do not guide the initial selection of components from the lists in Gallucci '399. Thus, Applicants submit that the rejection is in error and should be withdrawn.

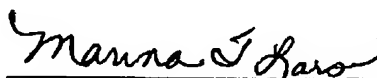
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The Examiner also rejected claims 1-4 and 9-20 as obvious over the combination of Fromuth and Gallucci '049. Fromuth teaches various types of stabilizers. These include the ones that the Examiner has named in reliance on the present claim, but also other stabilizers that are not claimed in the present application. Fromuth does not specifically disclose combinations of stabilizers, and does not guide a person skilled in the art to make the necessary choices to arrive at the presently claimed invention. Thus, this combination of references suffers from the same defect as discussed above and the rejection should be withdrawn.

Claims 5-8 are rejected under 35 USC § 103 as obvious over Gallucci '399 in view of Gallucci '049, Fromuth, and further in view of Pixton (US 6,187,848). Pixton is cited for the disclosure of specific thioesters, but does not address the issues discussed above. Thus, this rejection should be withdrawn for the same reason.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,



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